UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,755	11/03/2000	Hideaki Furukawa	35.C10563 REI	4371

5514 7590 12/20/2006

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER	
PAN, DANIEL H	
ART UNIT	PAPER NUMBER
2183	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/20/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/704,755	FURUKAWA, HIDEAKI	
	Examiner	Art Unit	
	Daniel Pan	2183	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 October 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *138-153* is/are pending in the application.

4a) Of the above claim(s) *1-137* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *138-153* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 November 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. Claims 138-153 remain for examination. Claims 1-137 have been canceled. Upon further review, claim 138,142 are, in addition to prior art of record, rejected based on new grounds of rejection. This is a non-final in order to allow applicant a chance to respond. However, response to applicant's remarks will be included to clarify the teaching of prior art. Kusumoto et al. (5,012,281) is a newly found art.

> 35 U.S.C. 101 reads as follows:
>
> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 138 and 142 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The reasons are given below.

3. As to claim 138, no substantial practical application can be found in the claim. Although claim recites the output control apparatus for operable to communicate the information apparatus via a network (see preamble), and the print counting means for counting , the trouble counting means for counting, the determination means for determining, the transmission control means for controlling the transmission if the number determined reached to a predetermined number (see claim body), it is intended use, not a positive recitation of the limitation. No network components nor any structural and functional interrelationships between the transmission and other claimed elements of the output control apparatus which permit the communication's

functionality to be realized. Although claim additionally recites the repeatedly initialization (see claim 1, line 3 from the bottom), it is directed to mere update of the count value and the manipulation of abstract ideas (e.g. count value) without practical application. Therefore, claim 138 is non-statutory. See also *Schrader*, 22 F.3d at 293-94, 30 USPQ2d at 1458-59, or *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759.

4. As to claim 142, claim 142 has similar features with claim 138, the same analysis is also applicable to claim 142.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 138, 142 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kusumoto et al. (5,012,281) in view Nakahara et al. (5,172,244).

6. As to claim 138, Kusumoto taught at least :

a) print counting means for counting a print count value indicating a number of prints in response to delivery of a print sheet printed (see the print counter in col.10, lines 21-65, see also fig.5, [print sheet counter]);

b) trouble counting means [JAM COUNTER]for counting updating a trouble count value indicating a number of print troubles when a print trouble occurs (see fig.4 [JAM COUNTER A03];

c) determination means for determining whether or not the print count value counted by the print counting means reaches a predetermined value (see increment and decrement of Cps in col.10, lines 46-65) ;

d) transmission control means for controlling transmission of trouble data on the predetermined value (see the occurrence of jamming in col.10, lines 51-68, col.11, lines 1-32) including the trouble count value counted until the print count value reaches the predetermined value , such that the trouble count value indicating the number of troubles counted until the print count value reaches the predetermined value at said output control apparatus (see the detection of jamming and the jam counter in col.11, lines 34-61); and

e) initialization means(see fig.6A [c05])for, if said determination means determines that the print count value counted by the print counting means reaches the predetermined value, initializing the trouble count value see the reset of jam counter in col.13, lines 16-28).

7. Kusumoto did not specifically show the initialization means were repeatedly perform the initialization when the print count value counted by the reached the predetermined value as claimed. However, Nakahara also taught reputedly initialization (see the data of the image switched to the initial modes automatically in col.4, lines 62-68). It would have been obvious to one of ordinary skill in the art to use Nakahara in Kusumoto for repeatedly performing initialization as claimed because the use of Nakahara could provide Kusumoto the ability to start the detection of the troubled data automatically without the interruption of the operator, and because Kusumoto did

disclose to reduce the maintenance and servicing efforts of operator (see col.14, lines 45-53), which was the suggestion of the need for providing the repeatedly initialization in order to minimize the interruption by the operator, for the above reasons, provided a motivation.

8.

9. Claims 138-153 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakahara et al. (5,172,244) in view of Sakata (4,905,098).

10. As to the newly amended feature of repeatedly perform initialization, Nakahara also taught reputedly initialization (see the data of the image switched to the initial modes automatically in col.4, lines 62-68).

11. The rejections are maintained and incorporated by reference the last Office action on 06/13/06.

12.

13. In the remarks, applicant argued that :

a) Sakata is silent on a transmission control means controlling transmission of trouble data including the trouble count counted until the predetermined value.

14. As to a) above, Sakata was used to supplement the teaching of the number of troubles (see page 13, Paragraph 31 of the last Office action on 06/13/06) . As to the feature of transmission control means controlling transmission of trouble data including

the trouble count counted until the predetermined value, Nakahara taught a transmission control means (see fig.8B [s32,s31] for transmitting trouble data (e.g. print mode such as plotter number ps, number of copies) until the print count reaches a predetermined value (s25) to a predetermined one of at least higher class apparatus [px] (see fig.8A s 10 for higher apparatus in order px+l, see the transmission of mode data into the selected plotter ps in fig.8B, see co1.6, lines 40-66, col.7,m lines 1-27).

15. Nakahara did not specifically show his trouble data (see co1.3, lines 60-65) included a number of troubles as claimed. Nakahara showed the pint count and updated count (see the set number and count number in co1.3, lines 56-64, col.6, lines 9-39). However, Sakata disclosed a system including a trouble count (see the jam counter in co1.11, lines 18-34). It would have been obvious to one of ordinary skill in the art to use Sakata in Nakahara for including the number of troubles as claimed because the use of Sakata could provide Nakahara the ability to process the number of prints based on an additional condition in order to track the number of prints with the number of the troubled copies, such as the jammed paper, thereby increasing the processing adaptability of Nakahara, and it could be readily achieved by predefining the jam counter of Sakata with modified counter parameter (e.g. the counter port) into Nakahara so the jam counter could be recognized by Nakahara to achieve the enhanced adaptability, and because Nakahara showed the pint count and updated count (see the set number and count number in co1.3, lines 56-64, col.6, lines 9-39), which was a suggestion of the need for providing a trouble count, such as the jammed

number between the set count and count number of the paper in order to provide a feedback number, in doing so, provided a motivation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Pan whose telephone number is 571 272 4172. The examiner can normally be reached on M-F from 8:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chan, can be reached on 571 272 4162. The fax phone number for the organization where this application or proceeding is assigned is 703 306 5404.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

21 Century Strategic Plan